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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/534,376	10/24/2005	Andreas Dietz	10537/289	3384
26646 7590 12/19/2008 KENYON & KENYON LLP ONE BROADWAY NEW YORK, NY 10004				
EXAMINER				
LEADER, WILLIAM T				
ART UNIT		PAPER NUMBER		
1795				
MAIL DATE		DELIVERY MODE		
12/19/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No. 10/534,376	Applicant(s) DIETZ ET AL.
Examiner WILLIAM T. LEADER	Art Unit 1795

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 11 December 2008 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☒ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 9-15.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☐ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____
13. ☒ Other: _____.

/William Leader/

/Harry D Wilkins, III/
Primary Examiner, Art Unit 1795

Continuation of 3. NOTE: Claim 9 as previously presented recited a deposition bath in which particles including at least one of (a) Mg, (b) Ti and (c) Zn were suspended. Applicant's proposed amendment adds the limitation of claim 12, which recites that the deposition bath includes suspended silicon particles, to claim 9. Thus, claim 9 as proposed, may include two different types of particles, i.e., particles from the initially recited group and silicon particles. Dependent claim 11 recites that the particles are alloyed with at least one of (a) Ni, (b) Co and (c) Pt. It is not clear which of the particles recited in proposed claim 9 claim 11 refers to. If claim 9 is amended as proposed, claim 11 may refer to the silicon particles. The only discussion of silicon particles in the specification as filed appears to be on page 8, lines 9-20. Basis in the specification as filed for alloying at least one of (a) Ni, (b), Co and (c) Pt with silicon particles is not apparent. Consequently, claim 9 as proposed raises the issue of new matter.

Continuation of 13. Other: At page 4 of the Remarks, applicant argues that the deposition bath of Thoma does not include suspended silicon particles, but particles of titanium and silicon. As noted above, claim 12 recites suspended silicon particles. The claim does not recite that the particles "consist of" silicon and, as written, is considered to be open to the inclusion of other constituents such as Ti in the particles. With respect to claim 11, at page 6 of the Remarks, applicant points out that none of the alloy powders of Thoma et al include Pt. While this may be correct, claim 11 does not require that the particles contain Pt, only at least one of (a) Ni, (b) Co and (c) Pt. Applicant notes that only one powder of Thoma et al contains Ni, and only one contains Co. Applicant argues that Thoma nowhere mentions that the titanium in the particles in alloyed with Ni, Co or Pt. These arguments are not persuasive. By including a particle that contains Ni and particle that contains Co in the list of examples, Thoma et al is considered to teach that Ni and Co are useful elements to include in alloy powders used to form a corrosion resistant coating. The combination of these known useful alloying elements in an alloy with other metals such as Ti, known to be useful for the same purpose, would have been obvious.